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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
GREENE, DANIEL LAWSON	
ART UNIT	**PAPER NUMBER**
3694	

MAIL DATE	DELIVERY MODE
05/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/540,648	SKURIAT ET AL.	
	Examiner	Art Unit	
	Daniel L. Greene Jr.	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 January 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8 and 10-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8, 10-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 2/12/07
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Amendment

2. Applicant's amendment to claim 10 has overcome the objection set forth in section 3 of the previous Office action mailed 12/20/2006. Accordingly, said objection is withdrawn.

Response to Arguments

3. Applicant's arguments filed 1/30/2007 have been fully considered but they are not persuasive.

4. Applicant argues:

> "Applicants respectfully assert that the Examiner's 35 U.S.C. § 103 rejection is improper for at least two reasons. First, the Examiner has not established a prima facie case of obviousness, and second, the use of the Answers.com reference that cites Wikipedia is not a proper reference.
>
> Applicants are under no obligation to submit evidence of nonobviousness in the absence of a prima facie case of obviousness being proven by the Examiner. See M.P.E.P. § 2142. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.
>
> M.P.E.P. § 2143. Specifically, Applicants respectfully assert that the Examiner has not satisfied at least the third criterion of the prima facie case of obviousness. The Examiner has not provided a reference that discusses "a measure of performance" as recited in the respective independent claims"

5. Response: First, the Wikipedia article was cited as support for the Examiners contentions of what is known in the art. The Examiner has attached Mitchell and White to the instant Office action to support what the Examiner stated in the previous Office action, that is Mitchell and white set forth in detail the methodology behind six sigma

including that it was known since 1988, it is focused on the customer, it is concerned with, for example, total cycle time reduction, it uses statistics (which requires measurement points, charts, analysis, etc.) and that "Six Sigma is a lot of things: a methodology, a philosophy, an exercise in statistics, a way of doing business, a tool for improving quality". All of these things are exactly what applicant's invention is directed towards. Applicant cannot properly argue against the Examiners assertions without overlooking the teachings of the references. See *In re Conrad*, 169 USPQ 170 (CCPA 1971) "The test for obviousness under U.S.C. 103 is not the express suggestion of the claimed invention in any or all of the references but **what the references taken collectively would suggest**" (Emphasis added.)

Second, as explained in section 8 of the previous Office action mailed 12/20/2006, the references do indeed teach and suggest all of the claim limitations, see for example, page 7, second paragraph. Specifically, the references do indeed teach and suggest measuring performance and therefor a measure of performance. For arguments sake, even if the Examiner did not specifically assert that the references do not disclose generating a measure of performance (which is done on said page 7), applicant cannot simply ignore the teachings of the references. See, *In re Shepard*, 138 USPQ 148 (CCPA 1963) "In considering disclosure of reference patents, it is pertinent to point out not only specific teachings of patent but also the **reasonable inferences which one skilled in the art would logically draw therefrom**." (underlining added)

Third, Ibarra clearly sets forth a system and method for quantifying human performance. As per, for example, Col. 2, lines 48-64, the employee and supervisor sit

down and set forth measurable objectives of performance, i.e. measure of performance. Further, Hawkins itself sets forth motivation to increase the effectiveness of expediting settlements as well as other objectives. Page 9 first paragraph of said previous Office action (Ameritrade article) also sets forth further evidence that those in the trade business are deeply concerned with the speed of order execution. Applicant's arguments to the contrary are simply untenable. The Examiner has shown how the references themselves set forth the importance of faster execution of trades in the quest for, for example, profit, market share, customer satisfaction, etc. Again resort may be had to Ibarra, Col. 2 line 62 "Therefore by looking at how close the employee is to meeting the standard, the employee and the employer can determine which activities are most likely to result in the employee meeting the standard". The Ameritrade article sets this standard at 10 seconds. This measure of performance can only be accomplished by measurements taken from viable and decisive locations that relate to the performance to be measured. See *In re Fout*, 213 USPQ 532 (CCPA 1982), *In re Siebentritt,* 152 USPQ 618 (CCPA 1967) " Express suggestion to substitute one equivalent technique for another need not be present to render such substitution obvious"

The Examiner has cited columns and line numbers for the convenience of applicant. Applicant should not review the references with blinders on, but review the entire documents for what they teach to one of ordinary skill in the art. The Examiner included the references to Six Sigma as additional evidence of process improvement philosophies that are considered basic knowledge. Regardless of the original source,

i.e. Wikipedia, it was cited for applicant's benefit to help applicant better understand the concept and application of Ibarra to Hawkins. That is, an additional motivation to better the process set forth in Hawkins. We should not forget that Hawkins itself sets forth motivations to improve upon itself. Applicant's assertion that the references of record do not set forth the precise and specific terms set forth in applicant's claims is considered evidence that Applicant is not considering the TEACHINGS of the references and how these TEACHINGS would be applied. To be sure, the references of record do indeed set forth each and every limitation set forth in applicant's claims, they merely use different terminology, however such terminology is synonymous to and reads on applicant's inventive concept. Accordingly applicant's arguments are not persuasive.

Applicant cannot argue against the references individually by attacking them individually where the rejections are based on combinations of said references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

7. Claims 1-8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,029,146 to Hawkins et al. (hereafter Hawkins) in view of both U.S. Patent 5,727,165 to Ordish et al. (hereafter Ordish) AND the definition of Six Sigma obtained from Answers.com and further in view of U.S. Patent 6,119,097 to Ibarra for the reasons set forth in section 8 of the previous Office action mailed 12/20/2006.

The Examiner has elaborated on how the references read on the invention as claimed in section 5 above.

8. Claims 1-8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of International Publication WO 99/56192 to Gatto provided by applicant via IDS dated 2/2/2007

Hawkins sets forth a device and method of improving the speed and reliability of security trade settlements including the motivation to increase the speed and accuracy of settling an executed trade, (reads on post- trade) in, for example, the abstract, col. 1, lines 18-33 and 65+, col. 2 lines1-7 and 42+, col. 3 lines 1-5, col. 4 lines 24-47, etc.

Hawkins explicitly sets forth beginning in col. 1 lines 18, "To meet these challenges and improve profitability, financial institutions **will need to re-engineer business processes to increase efficiency**, automate to reduce costs and expedited settlement and move towards proactive risk management." (Emphasis added)

Hawkins sets forth a system providing a trade management process, said trade management process including transmitting trade-related information between said participants, said system comprising:

a trade management system configured to receive at least two post-trade communications including first and second communications Col. 2 lines 42-col. 3 line 23), at least said first communication is from a first participant to said trade management process, each of said first and second communications including information associated with one or more steps in a process for closing a trade (col. 3 lines 1-5);

a database configured to store time-of-completion information (col. 4 lines 33-47) including at least one time-of-completion value representative of a time of completing at least a selected step of said steps in a process for closing a trade measured from a start time, wherein said time-of-completion value is recorded when said first communication is received by said trade management system; and

Hawkins does not appear to expressly disclose a processor configured to generate a post-trade measure of performance, with respect to said first participant, as a function of a difference between said start time and said time-of-completion, said measure of performance being a function of a time elapsed between completion of successive ones of said steps in said process for closing a trade nor does it expressly disclose providing a measure of performance.

Hawkins does however expressly set forth motivations to "re-engineer business processes to increase efficiency...expedite settlement, and move towards proactive risk management.", "settlement failures...has been estimated at as much as 30%" and that "delays in achieving confirmation are costly...reducing the profit margin on these transactions."

To be clear, these words set forth (in a verbose manner) the basic premise of measuring the time it takes for an individual to receive an order to the time the order is completed. This phenomenon is considered to be commonplace and old and well known. That is, a waiters tip is based in part in the amount of time it takes from the time a person places their order to the time they get their food, however there are many steps in that process like writing the food order on a pad, giving the order to the cook, the cook cooking it, the waiter delivering it, etc. Applicant's inventive concept is nothing more than automating that which is old and well known and applying it to the trading environment.

Gatto sets forth a system and method of analyzing security analyst performance in their duties. Gatto teaches it is known in the security analyst are to track and analyze the performance of security analysts in how accurately they perform their job, i.e. analyze and predict securities. Gatto sets forth a plethora of ways to manipulate the information surrounding said analysts, including the ability to choose and exclude analysts being monitored, time frames for the monitoring, etc. etc. etc. See for examples, the Abstract, Page 4 lines 7 though page 5 line 4, etc.

Gatto is considered as supporting the Examiners allegations that it is known in the field of securities (stocks are a security) to monitor the performance of the individuals working in the field. Gatto also teaches that it is known to monitor various specific elements, assign weighted factors to elements, and to provide the ability for additional elements to be monitored not previously available, that is, Gatto allows for the user of the system to make up any element they wish to monitor, they don't just have to choose from a canned list of elements.

At the time of the invention it would have been obvious to one of ordinary skill in the art to apply the teachings of Gatto to the system of Hawkins to arrive at a system and method of monitoring the performance of individuals (traders) performing trade management functions for the benefits of, for example, increasing effectiveness of the trading process, increasing profit, increasing customer satisfaction, etc. It is further considered obvious on it's face that in order to measure the performance of an individual performing his duties of managing a trade that the time it takes to consummate said trade would be monitored as such is the primary duty of said trader. Again the Examiner has shown the importance of the speed at which the order is executed in the trade market.

Claims 2 and 10-14 recite various limitations defining exactly when or where the measurements of performance are measure from, however these limitations are nothing more than design choices and would be obvious to one of

ordinary skill to select any time they wish to compare with other times in order to define an area needed for improvement. Again, resort may be had to the analogy of ordering food at a restaurant. Does the waiter need to walk faster to the kitchen, does the cook need to cook faster or be more efficient in telling the waiter the food is done? Again, resort may be had to the TEACHINGS of the references to show applicants various specific recitations would be obvious.

Claims 5-9 set forth a system performing the method as explained above and as such are rejected for the same reasons.

Summary of invention.

9. Applicant's invention is drawn to nothing more than a system and method for measuring the performance of an individual in the performance of his duties. Applicant has automated this process and applied it to the trade management process and set forth in the claims specific locations at which the performance may be measured, by measuring the amount of time it takes for and individual to perform certain tasks in a list of tasks that must be performed in a specific order.

Conclusion

10. Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested from the applicant, in preparing the responses, to **fully consider the references in entirety** as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

11. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) on 2/2/2007 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene Jr. whose telephone number is (571) 272-6876. The examiner can normally be reached on Mon-Fri 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DIG
2007-04-27

ELLA COLBERT
PRIMARY EXAMINER